

III. REMARKS/ARGUMENTS

A. Regarding the Amendments

Claims 5-10 are pending. No claim amendments have been made in this response.

The specification has been amended ²to recite that "[t]he cross-sectional area of the inlet channel 144 usually is larger than the cross sectional area of the delivery channel 140, *e.g.*, at least about 1.5 times or 2 times the cross-sectional area of the delivery channel 140." Support can be found, *inter alia*, in claims 7 and 8 as originally filed.

No new matter is added by the amendments. Entering of the amendments is respectfully requested.

B. Objection to the Specification

The specification is objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. The Office Action states that claims 7 and 8 do not have antecedent basis in the specification and references MPEP §608.01 (o) as its basis for the objection.

Applicants respectfully point out that according to MPEP §608.01 (o), "[t]he meaning of very term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies." (emphases added).

With respect to claims 7 and 8, the Office Action fails to point out the term or terms, the meanings of which are not apparent from the descriptive portion of the specification. The dimensions of the siphon are mathematical numbers, but not terms that require antecedent basis in the descriptive portion of the specification. Withdrawal of the objection is respectfully requested.

In the event that the objection is not withdrawn based on the arguments presented above, Applicants respectfully request the entering of the amendments to the specification as indicated

² See comments made under Section B.

under Section II, **AMENDMENTS TO THE SPECIFICATION** to expedite prosecution. The amendments to the specification specifically recite the dimensions of the siphon including the dimensions set forth in claims 7 and 8.

C. Rejections under 35 U.S.C. §102(a)

Claims 6 and 10 are rejected as being anticipated by Tech Update. Claims 5-6 and 10 are rejected as being anticipated by Abaxis Inc. These rejections are respectfully traversed.

Applicants respectfully submit a Declaration by one of the inventors, Carol T. Schembri under 35 U.S.C. 1.132. See Exhibit A. As stated in the Declaration, the named inventors, Anne R. Kopf-Sill and Carol T. Schembri developed, directed and supervised the scientific protocol and the course of experiments leading to the disclosure in Tech Update and Abaxis Inc. The disclosure of Tech Update and Abaxis Inc. reveals the work carried out by the named inventors or by others supervised by the named inventors. Therefore, the disclosure of Tech Update and Abaxis Inc is not disclosure by another, but disclosure of the named inventors of the present application. Thus Tech Update and Abaxis Inc. can not be used as references to support the rejections. Withdrawal of the rejections is respectfully requested.

D. Rejections under 35 U.S.C. §103(a)

Claims 7-9 are rejected as being obvious over Tech Update or Abaxis Inc. These rejections are respectfully traversed.

The Office Action states that "Tech Update fails to teach the channel dimensions." Applicants respectfully point out that Tech Update not only fails to teach the channel dimensions, but also fails to show how the siphons are connected to each chamber and how the liquid travels within each siphon, *e.g.*, Tech Update does not enable the invention as claimed in claims 7-9. For example, Tech Update is silent as to which chamber is the receiving chamber, which chamber is the dispensing chamber, which part is the siphon inlet and which part is the siphon outlet. Tech Update also fails to convey or suggest to one skilled in the art how each siphon interacts with each chamber and how each siphon travels. In the absence of any teaching, it would not be obvious to one skilled in the art to construct the siphon and the chambers as recited in the claims.

The Office Action states that the cited company brochure fails to teach the channel dimensions, however the specific dimensions recited in the claims would have been obvious to one skilled artisan. Applicants respectfully point out that the cited company brochure is silent as to the cross sectional areas of the inlet channel, delivery channel, and the relationship thereof. The cited company brochure also fails to teach or suggest how to use the dimensions of the cross sectional areas of the inlet channel and delivery channel to facilitate the liquid flow and air escape in the system.

The Office Action states that it would have been obvious to one of ordinary skill in the art to optimize the channel dimensions in order to optimize the fluid transfer as taught. Applicants respectfully submit that the issue is not whether it would have been obvious to one skilled in the art to optimize the channel dimensions in order to optimize the fluid transfer as claimed in the present invention. In order to make its prima facial case of obviousness, the Office Action has to establish at least that 1) one skilled in the art would have been motivated to experiment the claimed invention, 2) the experiments required would not have been undue, and 3) one skilled in the art would have had reasonable expectation of success prior to experiment the claimed invention. The Office Action does not provide any evidence as to why one skilled in the art would have been motivated to try the particular siphons claimed in the present invention, why the experiments leading to the claimed dimensions would not have been undue, and why one skilled in the art would have had reasonable expectation of success with respect to the particular channel dimensions claimed in the present invention.

Both Tech Update and Abaxis Inc. are silent as to the cross sectional areas of the inlet channel, delivery channel, and the relationship thereof. Tech Update and Abaxis Inc. also fail to teach or suggest how to use the dimensions of the cross sectional areas of the inlet channel and delivery channel to facilitate the liquid flow and air escape in the system. In the absence of any teaching or suggestion, it would have been undue for one skilled in the art to experiment on his or her own in deciding what would be appropriate cross sectional dimensions for the inlet channel and the delivery channel, especially what would be the suitable relationship and ratio between the inlet channel and the delivery channel. For example, one skilled artisan could have thought that the cross sectional area of the inlet channel should be the same dimension as that of

the delivery channel according to the figure of Tech Update or Abaxis Inc., and would not have been motivated to try other dimensions.

Even if for the purpose of discussion we suppose that one skilled artisan might have decided to try other dimensions, he or she could have chosen sets of dimensions where the cross sectional area of the inlet channel is smaller than that of the delivery channel. Alternatively even if we suppose a skilled artisan could have chosen a set of dimensions where the cross sectional area of the inlet channel is larger than that of the delivery channel, it would still have been at most obvious to try without any reasonable expectation of success. Therefore, the Office Action fails to make its *prima facie* case of obviousness based on Tech Update or Abaxis Inc.

Alternatively, applications respectfully submit that the cited disclosure of Tech Update and Abaxis Inc is the disclosure by the inventors of the subject application, not disclosure by another, thus can not be used as basis for the rejection.

Specifically, applicants respectfully submit a Declaration by one of the inventors, Carol T. Schembri under 35 U.S.C. 1.132. See Exhibit A. As stated in the Declaration, the named inventors, Anne R. Kopf-Sill and Carol T. Schembri developed, directed and supervised the scientific protocol and the course of experiments leading to the disclosure in Tech Update and Abaxis Inc. The disclosure of Tech Update and Abaxis Inc. reveals the work carried out by the named inventors or by others supervised by the named inventors. Therefore, the disclosure of Tech Update and Abaxis Inc is not disclosure by another, but disclosure of the named inventors of the present application, thus can not be used as references to support the rejections.

In summary, the claimed invention is not obvious over the disclosure of cited prior art. Withdrawal of the rejections is respectfully requested.

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Reply to Office Action of July 15, 2003

In view of the amendment and the above remarks, it is submitted that the claims are in condition for allowance and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to this application.

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Respectfully Submitted,

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